

III. REMARKS

1. Claims 1, 17, 20, 34, 45 and 47-51 are amended. Claims 1-6, 9-17, 20-26, 28-34, 36-42 and 44-51 are currently pending in this Application.

2. Claims 48-51 are amended to address the noted objection.

3. Claims 45, 47, 49 and 51 are amended to address the 35 U.S.C. § 112, first paragraph rejection.

4. Claims 1-6, 10-13, 15-16, 20-26, 29-30, 32-33, 36-39, 41, 44-45 and 48-49 are not unpatentable over Cuddy, U.S. Patent 6,246,761, in view of Grothause, U.S. Patent 4,904,992, under 35 U.S.C. § 103(a). Independent claim 1, as amended, recites the determining means are arranged to determine the moments at which a sudden background noise of a predetermined duration occurs regularly, and the control means are arranged to produce a tone nonsimultaneously with and in between the moments at which the sudden background noise occurs regularly. Neither Cuddy nor Grothause, individually or in combination, disclose or suggest these features.

Claim 45 previously recited that the sudden background noise of a predetermined duration occurs regularly. Thus this change should not require any additional consideration or search and entry of this amendment is solicited.

Cuddy discloses a telephone with a means for automatically generating ringing tones to be heard by a user over ambient noise and in spite of any muffling environment in which the telephone may be located. The ambient noise is measured to determine its amplitude and frequency characteristics and appropriate amplitude and frequency characteristics of ringing tones to be heard by a

user over the ambient noise are calculated and generated. In Cuddy, the ringing tones are calculated by consulting a look-up table in the DSP chip's memory incorporating records relating to different possible ranges of amplitude and frequency characteristics of the ambient noise (Col. 5, L. 39-59). The degree to which the ringing tones are muffled is also calculated and suitable amplitude and frequency characteristics of the ringing tones necessary to be heard by the user are generated (Col. 7, L. 16-35). Nowhere does Cuddy disclose or suggest determining the moments at which a sudden background noise of a predetermined duration occurs regularly, and the control means are arranged to produce a tone nonsimultaneously with and in between the moments at which the sudden background noise occurs regularly as called for in claim 1.

In the Office Action mailed September 8, 2005, the Examiner states that Grothause, in column 2, lines 55-66, reads on "regularly" as recited in claim 45. Applicant respectfully submits that this interpretation of Grothause is incorrect.

Grothause at column 2, lines 55-66 reads "[t]he present invention contemplated that the radio user may enter a wide variety of sound (or noise) environments during day-to-day operations. For example, a plant manager may operate partly in an office environment, and partially in manufacturing environment. If the radio operator has selected the audible alert feature (via the keypad 40) or has inactivated the silent alert vibrator 36, it may be impossible for the radio user to hear the audible alert when operating in a high noise (or sound level) environment. Thus, the radio user may not respond to a received message since he or she is unaware of its operation." This quote clearly illustrates a situation where a person may work in two different

environments (e.g. in an office and in a manufacturing environment). In the example, an audible alert may not be heard in the manufacturing environment, because the user has selected the suitable alert feature for the office environment.

Significantly, what the passage states is that the radio user may enter a "wide variety" of sound environments. There is nothing stated or disclosed here that indicates that this "wide variety" of noise is "sudden", of a "predetermined duration" or that it occurs "regularly." Rather, what the passage clearly states and implies is that the user will encounter many different noise environments during day to day operations. While "day to day" working may occur "regularly", this is not the same as the "sudden background noise of a predetermined duration occurs regularly", as is recited by Applicant in the claims.

Grothause does not disclose that there is an analysis on the regularity of the noise. Rather, if the user walks from the office to the manufacturing environment, Grothause just measures the ambient sound level. Grothause does not analyze whether the noise in the manufacturing environment has some kind of regularity, such as regularly occurring hammer blows as in the present Application, for example (see page 5, lines 4-13 of the Application).

Thus, claim 45, and now claim 1, are not obvious over the combination of Cuddy and Grothause, since the combination does not disclose or suggest that "sudden background noise of a predetermined duration occurs regularly", or an analysis thereof.

Grothause discloses a radio (10) that operates to compare the ambient sound to a threshold level whenever a message is received (Col. 2, L. 66 - Col. 3, L. 5). If the ambient noise level is

above an upper threshold a silent enunciator on the radio is activated (Col. 3, L. 22-27). If the ambient noise is below a lower threshold the silent enunciator is activated (Col. 4, L. 23-28). If the ambient sound is between the upper and lower thresholds a selected enunciator is activated (Col. 3, L. 17-20; Col. 4, L. 18-22). Grothause also discloses delaying or storing the message until the ambient sound falls below the threshold (Col. 3, L. 53-68). Nowhere does Grothause disclose or suggest determining the moments at which a sudden background noise of a predetermined duration occurs regularly, and the control means are arranged to produce a tone nonsimultaneously with and in between the moments at which the sudden background noise occurs regularly as called for in claim 1.

The storing of the messages of Grothause "provides the radio operator with a choice to receive only tone alerts (at the risk of receiving delayed messages)" (Col. 3, L. 63-65). This evidences that Grothause does not disclose or suggest determining the moments at which a sudden background noise of a predetermined duration occurs regularly, and producing a tone nonsimultaneously with and in between the moments at which the sudden background noise occurs regularly as called for in claim 1. The tone alert of Grothause will not enunciate as long as the ambient sound is present thereby producing the delayed message. This is not what is recited in Applicant's claim 1.

Furthermore, Applicant respectfully submits that there is no suggestion or motivation to combine Cuddy and Grothause. Applicant finds no suggestion in the nature of the problem to be solved, in the references themselves, or in the knowledge generally available to one of ordinary skill in the art to modify or combine the references.

If Cuddy and Grothause were combined the result would be a telephone that compares the ambient sound to a threshold level and stores a message when ambient sound above the threshold. The telephone would also produce a silent enunciation that alerts a user of an incoming call if the ambient noise is above or below a certain threshold or if the ring tones are muffled. This is not the same as determining means are arranged to determine the moments at which a sudden background noise of a predetermined duration occurs regularly, and the control means are arranged to produce a tone nonsimultaneously with and in between the moments at which the sudden background noise occurs regularly, as recited in Applicant's claim 1. Thus, it would not be obvious to a person skilled in the art at the time the invention was made to combine Cuddy and Grothause to arrive at what is claimed in Applicant's claim 1 and a *prima facie* case of obviousness is not established.

Claim 20, as amended, recites determining the moments at which a sudden background noise of a predetermined duration occurs regularly and producing a tone nonsimultaneously with and in between the moments at which the sudden background noise occurs regularly. Claim 20 is patentable over the combination of Cuddy and Grothause for reasons similar to those discussed above with respect to claim 1.

Claims 2-6, 10-13, 15-16, 21-26, 29-30, 32-33, 36-39, 41, 44-45 and 48-49 are patentable by reason of their respective dependencies.

5. Claims 1, 2, 6, 9, 20, 21, 25-26, 28, 39-40, 44-45 and 48-49 are not unpatentable over Cannon et al., U.S. Patent 6,269,257 ("Cannon"), in view of Grothause under 35 U.S.C. § 103(a).

Cannon discloses a telephone having a paging mechanism and an alerting mechanism in which the alerting mechanism can be adjusted to exceed the ambient noise in volume by a particular amount. Cannon also discloses that the pitch or other qualities of the alerting signal can be selected so that they do not overlap with those of the ambient noise (Col. 5, L. 16-26). Cannon does not disclose or suggest determining the moments at which a sudden background noise of a predetermined duration occurs regularly, and the control means are arranged to produce a tone nonsimultaneously with and in between the moments at which the sudden background noise occurs regularly as called for in claim 1. As noted previously Grothause does not disclose or suggest that "sudden background noise of a predetermined duration occurs regularly", or an analysis thereof. Thus, the combination of Cannon and Grothause does not disclose or suggest these features as well.

Furthermore, Applicant respectfully submits that there is no suggestion or motivation to combine Cannon and Grothause. Applicant finds no suggestion in the nature of the problem to be solved, in the references themselves, or in the knowledge generally available to one of ordinary skill in the art to modify or combine the references.

If Cannon and Grothause were combined the result would be a telephone that either produces a variable pitch alerting signal that exceeds an upper ambient noise threshold, stores a message when the ambient noise is above the threshold or produces a silent enunciation when the ambient noise is above or below an upper or lower threshold. This is not what is claimed in Applicant's claim 1. It would not be obvious to a person skilled in the art at the time the invention was made to combine Cannon

and Grothause to arrive at what is claimed in Applicant's claim 1 and a *prima facie* case of obviousness is not established.

Independent claim 20 is patentable over the combination of Cannon and Grothause for the reasons described above with respect to claim 1. Claims 2, 6, 9, 21, 25-26, 28, 39-40, 44-45 and 48-49 are patentable over the combination of Cannon and Grothause by reason of their respective dependencies.

6. Claims 17, 34, 39, 42, 46-47 and 50-51 are not unpatentable over Makela et al., FI 960858, in view of Grothause under 35 U.S.C. § 103(a). Claim 17 recites, the determining means are arranged to determine the moments at which a sudden background noise of a predetermined duration occurs regularly, and the control means are arranged to produce a tone nonsimultaneously with and in between the moments at which the sudden background noise occurs regularly. Neither Makela nor Grothause, individually or in combination, disclose these features.

Makela discloses a method for producing a ringing tone of a telephone comprising a sound generator, a memory for storing the ringing tone, a means for retrieving the ringing tone and for inputting the ringing tone into the sound generator for generating the ringing tone (Col. 3, L. 1-40). Makela also discloses the information defining a ringing tone is input as characters, each character defining the pitch and duration of a tone (Col. 4, L. 29 - Col. 5, L. 29). Nowhere does Makela disclose or suggest determining the moments at which a sudden background noise of a predetermined duration occurs regularly, and the control means are arranged to produce a tone nonsimultaneously with and in between the moments at which the sudden background noise occurs regularly as called for in independent claim 17.

If Makela and Grothause were combined the result would be a telephone having a ring tone that is input by the user as characters, where each character defines the pitch and duration of the tone. This user defined tone would be enunciated if the ambient noise is between an upper and lower threshold, a silent alert would be enunciating when the ambient noise is above or below the upper and lower thresholds respectively or a message would be stored when the ambient noise is above the upper threshold. This is not what is claimed in Applicant's claim 17. Claim 17 recites, the determining means are arranged to determine the moments at which a sudden background noise of a predetermined duration occurs regularly, and the control means are arranged to produce a tone nonsimultaneously with and in between the moments at which the sudden background noise occurs regularly. It would not be obvious to a person skilled in the art at the time the invention was made to combine Cannon and Grothause to arrive at what is claimed in Applicant's claim 17. Claim 17 is patentable over the combination of Makela and Grothause because neither Makela nor Grothause, individually or in combination, disclose or suggest the features of claim 17.

Independent claim 34 recites determining the moments at which a sudden background noise of a predetermined duration occurs regularly and producing a tone nonsimultaneously with and in between the moments at which the sudden background noise occurs regularly.

Independent claims 20 and 34 are patentable over the combination of Makela and Grothause for reasons similar to those described above with respect to claim 17. Claims 39 (which depends from claim 20), 42, 46-47 and 50-51 are patentable over the

combination of Makela and Grothause by reason of their respective dependencies.

7. Claims 14 and 31 are not unpatentable over Cuddy in view of Grothause and in further view of Lilja, U.S. Patent 5,844,983 under 35 U.S.C. § 103(a). As described above, neither Cuddy nor Grothause, individually or in combination, disclose or suggest the features of independent claims 1 and 20. Therefore, the combination of Cuddy, Grothause and Lilja cannot as well. Claims 14 and 31 are patentable by reason of their respective dependencies.

8. Claims 3 and 22 are not unpatentable over Cannon in view of Grothause and in further view of Lilja and Pohlmann (Pohlmann, K. C. "Principles of Digital Audio", MacGraw-Hill Companies, Inc., 1995, 3rd Ed. 1995, page 3) under 35 U.S.C. § 103(a). As described above, neither Cannon nor Grothause, individually or in combination, disclose or suggest the features of independent claims 1 and 20. Therefore, the combination of Cannon, Grothause, Lilja and Pohlmann cannot as well. Claims 3 and 22 are patentable by reason of their respective dependencies.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,



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